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EXAMINER

CORRIELUS, JEAN M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/809,943 | Applicant(s) BARNES-LEON ET AL. | |
| | Examiner Jean M. Corrielus | Art Unit 2162 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 and 24-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-22 and 24-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to the Request for Continued Examination filed on December 11, 2009, in which claims 2-22 and 24-44 are presented for further examination.

Response to Arguments

2. Applicant's arguments with respect to claims 2-22 and 24-44 have been considered but are moot in view of the new ground(s) of rejection.

3. The double patenting rejection has been overcome in light of the terminal disclaimer filed on December 16, 2008.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2-22 and 24-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 2 recites a method. However, such a method as claimed does not qualify as a 101 statutory process because claim 2 does not tie to an apparatus that accomplish the method steps. (See *In re Bilski*).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 2-22 and 24-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claims 2-22 and 24-44** recite “**common objects configured to pass**” and “**can be referenced.....**” The terms “**configured**” and “**can be**” signify system ability instead of “functional requirement”. There is no indication that limitation(s) following the terms “**configured**” and “**can be.**” are necessarily a required part of the claimed invention. Therefore, “**common objects configured to pass...**” and “**can be**” do not carry patentable weight unless the claim(s) are amended to recite the limitation in a definite form. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Block et al., (hereinafter "Block") US Patent no. 6,974,947 in view of Hougaard et al., (hereinafter "Hougaard" US Patent no. 6,216,130.

As to claim 2 and 24, Block discloses the claimed "receiving first data in a first format from a first source system" (first computer platform or system is automatically converted by a software module on the first platform, from a first format into an intermediate format, transferred to a second platform or system, and then converted from the intermediate format into a second format by a second software module on the second platform, see col.4, lines 23-28); "receiving second data in a second format from a second source system" (first computer platform or system is automatically converted by a software module on the first platform, from a first format into an intermediate format, transferred to a second platform or system, and then converted from the intermediate format into a second format by a second software module on the second platform, see col.4, lines 23-28); "store the first data and second data in an intermediate format" (intermediate format, see col.6, lines 45-52); "wherein the intermediate format is defined by a plurality of common objects the intermediate format form comprises a schema defining a plurality of common data type elements accessible by each of the plurality of common objects"(the intermediate format is an XML taxonomy, and software modules effectively "translate" so that data transparently exchanges between the two platforms regardless of whether the first and second formats are compatible or known to each of the two platforms, see col.4, lines 28-35); "a data element defined by one of the common data type elements has a consistent structure in each common object using that data element" (fig.1, mapped file structure); "said storing comprises mapping the first data and the second data to the intermediate format using one or more of the

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common data type elements” (converting the software module on the first platform, from a first format into an intermediate format, transferred to a second platform or system, and then converted from the intermediate format into a second format by a second software module on the second platform, see col.4, lines 23-28); and “providing the stored first data and second data to a target system in a target format” (col.6, lines 16-26). However, Block does not explicitly disclose the claimed feature “each common data type element is a reusable data structure”. On the other hand, Hougaard discloses the claimed feature “each common data type element is a reusable data structure” (administrator establishes an index of useable data structures located at disorganized data sources and makes the index available to any desired number of users in the organization, and the administrator organizes data references to allow customer service representatives, maintenance dispatchers, and other interested users to conveniently retrieve and view the geographic information likely to be of importance to the public utility, so in the absence of data references and other information stored by administrator application, individual users in the organization would be required to locate and organize the geographic data and other data structures, thereby engaging in inefficient duplication of effort, see col.7, lines 1-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teaching of the cited references, wherein system of Block would incorporate a reusable data structure, in the same convention manner as disclosed by Hougaard for the purpose of allowing customer service representatives, maintenance dispatchers, and other interested users to conveniently retrieve and view the geographic information likely to be of importance to the public utility.

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11. Claims 3-22 and 25-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Block et al., (herein after “Block”) US Patent no. 6,947,947 in view of Hougaard et al., (Hereinafter “Hougaard”) US Patent no. 6,216, 130 and further in view of Guyan et al., (hereinafter “Guyan”) US patent no. 7,124,112.

As to claim 3, Block and Hougaard substantially disclose the invention as claimed. On the other hand, Guyan discloses the claimed “payment card type element” (see col.11, lines 24-31, type of payment). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made combine the teachings of the cited references, wherein the enterprise computing system as disclosed by Block would incorporate the use of a payment card type element, in the same conventional manner as disclosed by Guyan see col.11, lines 24-31. One having ordinary skill in the art would have found it motivated to use such a combination in order to maintain a good relationship between the claimants and the enterprise computerized system.

As to claim 4, Block discloses the claimed “an application instance name element” (col. 6, lines 45-66, information exchange which translate data between models formats of various programs).

As to claims 5 and 7, Guyan discloses the claimed “an error type element” (col.1, lines 59-61, claim processing arenas).

As to claims 6, 8 and 17, Guyan discloses the claimed “message text element” (col.11, lines 65-67; col.14, lines 27-41, displays claimant level information)

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As to claims 9-12, Guyan discloses the claimed “cross reference ID” (col.10, lines 63-65, cross reference ID sub-element).

As to claims 13-14, Guyan discloses the claimed “a message code sub-element” (col.9, lines ICD-9 code indicating the treatment and other medical details).

As to claims 15-16, Guyan discloses the claimed “value cross reference elements” (col.10, lines 36-65, cross reference type and level data with the vendor database and queries for a listing authorized vendors).

As to claim 18, Guyan discloses the claimed “activity duration (end date) element” col.12, lines 15-20, maximum days allowed after the claims is closed).

As to claim 19, Guyan discloses the claimed “address line elements” col.12, lines 59-61, address line).

As to claims 20-22, Guyan discloses the claimed “ Id element, email element” (col.12, lines 59-61, email element).

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As to claims 25-44:

Claims 25-44 are computer programs for performing the method of claims 3-22. They are, therefore, rejected under the same rationale.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jean M Corrielus/
Primary Examiner, Art Unit 2162

December 23, 2008

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